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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/528,321	09/26/2005	Stephen Guffanti	100842.0002US	6770
24392 7590 10/28/2009 FISH & ASSOCIATES, PC ROBERT D. FISH 2603 Main Street Suite 1000 Irvine, CA 92614-6232				
EXAMINER				
GEBREMICHAEL, DRUK A				
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3715				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/528,321

**Applicant(s)**

GUFFANTI, STEPHEN

**Examiner**

BRUK A. GEBREMICHAEL

**Art Unit**

3715

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 July 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. The following office action is a **Final Office Action** in response to communications received on 07/17/2009. Claims 1, 7, 14-15 and 18 have been amended. Thus, claims 1- 20 are pending in this application.

### *Drawings*

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims.

Claim 14 recites "a reading assist card having a window". However, the drawings fail to illustrate this claimed feature as recited in the claim. FIG 10 of the current drawings appears to depict a "peeker" to represent the recited "reading assist card"; however, FIG 10 does not sufficiently illustrate the structure of the above claimed feature (e.g. it does not illustrate a card having a window). Therefore, the "reading assist card" must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate

changes made to the brief description of the several views of the drawings for consistency.

Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

- Claims 1-20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to a non-statutory subject matter.

Regarding claims 1-14, these claims are directed to a nonfunctional descriptive subject matter since there is no functional relationship between the printed matter and the substrate. It has been held that a mere arrangement of printed matter, though seemingly a "manufacture," is rejected as not being within the statutory classes. See *In re Miller*, 418 F.2d 1392, 164 USPQ 46 (CCPA 1969); *Ex parte Gwinn*, 112 USPQ 439 (Bd. App. 1955); and *In re Jones*, 373 F.2d 1007, 153 USPQ 77 (CCPA 1967).

Regarding claims 15-20, these claims are also directed to non-statutory subject matter because these are method or process claims that do not transform underlying subject matter (such as an article or materials) to a different state or thing, nor are they

ted to another statutory class (such as a particular machine). See Diamond v. Diehr, 450 U.S. 175, 184 (1981) (quoting Benson, 409 U.S. at 70); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978) (citing Cochrane v. Deener, 94 U.S. 780, 787-88 (1876)). See also In re Bilski (Fed Cir, 2007-1130, 10/30/2008) where the Fed. Cir. held that method claims must pass the "machine-or-transformation test" in order to be eligible for patent protection under 35 USC 101.

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

- Claim 3 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The phrase "at least 90%" in line 1 of claim 3 renders the claim indefinite since it is not clear what limitation(s) is encompassed in the scope of the claim.

### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

- Claims 1-13 and 15-20 are rejected under 35 U.S.C 102(b) as being unpatentable over "Rocket Phonics", (hereinafter Rocket Phonics).

Rocket phonics discloses the following claimed limitations:

Regarding claim 1, a system for teaching phonics, comprising a training apparatus that includes a visual representation of a plurality of words using ordinary spelling, and adjacently positioned clarifying symbols, wherein each clarifying symbol consists entirely of underlined or non- underlined letters of a standard alphabet (see Page 43),

Regarding claim 2, the clarifying symbols assist in sounding out at least part of each of the plurality of words (Page 44, lines 4-11),

Regarding claim 3, at least 90% of letters in the standard alphabet compose the clarifying symbols (Page 45),

Regarding claim 4, the clarifying symbols consist entirely of 24 letters of the English alphabet (Pages 120-124 and 143-147),

Regarding claims 5 and 6, the standard letters and the clarifying symbols together comprise an initial teaching alphabet consisting of less than 44 phonograms; the standard letters and the clarifying symbols together comprise an initial teaching alphabet consisting of 36 phonograms (Page 12),

Regarding claims 7 and 8, at least one of the symbols has a prompt that shows that a portion of one of the plurality of words form a blended sound; the prompt comprises a line under the plurality of the letters (page 27 and page 43),

Regarding claim 9, a coloration of a selected one of the standard letters to show that such letter is silent in the word (page 43, lines 8-9),

Regarding claims 10 and 11, a modification of a selected one of the standard letters to show that the selected letter sounds according to the adjacent phonetic symbol; the modification comprises colorizing the selected letter (Pages 43-44),

Regarding claims 12 and 13, differences in case of the letters are not used to represent differences in sound; the adjacently positioned clarifying symbols are placed below corresponding ones of the standard letters of at least some of the words (see Page 45),

Regarding claim 15, a method of teaching phonetic reading, comprising: presenting to a student an alphabet of phonetic symbols consisting of underlined and non-underlined letters selected from the group consisting of a, b, c, d, e, f, g, h, i, j, k, l, m, n, o, p, q, r, s, t, u, v, w, x, y, z; (Page 43), revising at least part of the word to include at least one of the phonetic symbols (Pages 44-45),

Regarding claims 16 and 17, phonetic symbols consisting of single letters correspond to short vowel sounds; phonetic symbols consisting of more than one letter represent long vowel sounds (Pages 49-50),

Regarding claim 18, displaying a line of words with ordinary spelling to the student and revising at least part of the line of words to include at least one of the phonetic symbols (Page 49),

Regarding claims 19 and 20, a sentence of at least five words with ordinary spelling, and placing phonetic symbols of the alphabet below selected ones of the words as aids in pronunciation of the selected words; displaying at least one of the words without a corresponding one of the phonetic symbols (Page 50).

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

- Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rocket phonics in view of Esbensen 4,196,529.

Regarding claim 14, Rocket phonics discloses the claimed limitations as discussed above.

Rocket phonics does not explicitly disclose, a reading assist card having a window.

However, Esbensen discloses a teaching device and method that teaches, a reading assist card having a window (col. 1, lines 7-23).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the invention of Rocket Phonics in view of Esbensen by incorporating a window card that has opening to Rocket Phonics's invention in order to help the student to learn the words in such a way that when the teacher reads a given word, the student attempts to get the letters that make the word through the openings of the window card, thereby learning the correct spellings.

***Response to Arguments.***

7. Applicant's arguments filed on 04/09/2009 have been fully considered. Applicant's argument regarding the drawings is not sufficient to overcome the objection



set forth in the previous office action, since the current drawings (e.g. see FIG 10 of Applicant's disclosure) do not illustrate the claimed feature "a reading assist card having a window" as recited in claim 14. FIG 10 appears to be a discussion about *blending sounds into words*. There is no illustration of a reading assist card that has a window.

- Regarding the rejection of the claims under 35 U.S.C. 101, please refer to the above section (section 3 above) as the reasons for the rejections is discussed separately based on the claimed subject matter (i.e. with respect to the system claims, claims 1-14; and the method claims, claims 15-20).
- The Examiner has also considered Applicant's Declaration under 37 CFR 1.131 that was filed on 04/09/2009 and on 07/17/2009. However, the declaration(s) does not overcome the 35 U.S.C. 102(b) rejection set forth in this Final Office Action since the reference (the book "*Rocket Phonics: Help your child reach for the stars*" submitted by Applicant on 07/17/2009), according to the information presented on **Amazon.com** and **U.S. Copyright** sources (please see the office communication that was mailed on 06/26/2009 that supports this evidence), was published on August 15, 2001, which is more than a year before the filing date of Applicant's provisional application (September 16, 2002). According to the 35 U.S.C. 102(b), A person shall be entitled for a patent unless **the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States**. Therefore, the declaration does not overcome the statutory bar established under 35 U.S.C. 102(b).

### ***Conclusion***

Applicant's amendment necessitated the new grounds of rejection presented in this final office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bruk A. Gebremichael whose telephone number is (571)270-3079. The examiner can normally be reached on Monday to Friday (7:30AM-5:00PM) ALT. Friday OFF.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, THAI XUAN can be reached on (571) 272-7147. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Bruk A Gebremichael/  
Examiner, Art Unit 3715

/Cameron Saadat/  
Primary Examiner, Art Unit 3715